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10/500,051	06/25/2004	Kazuhito Gassho	KYWAP008	9152

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EXAMINER	
NALVEN, ANDREW L	

ART UNIT	PAPER NUMBER
2134	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/500,051

Applicant(s)

GASSHO ET AL.

Examiner

Andrew L. Nalven

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 23-45, 47, 48, 51, 52 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-17, 22, 46, 49, 50 and 53-55 is/are rejected.
- 7) ☒ Claim(s) 7-10 and 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/12/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-58 are pending.
2. Claims 23-45, 47, 48, 51, 52, and 56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/27/2007. Applicant traversed on the grounds that claim 53 should have been included in elected Group I. Applicant's argument is persuasive. Claim 53 is hereby rejoined with Group I.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 49-50 and 54-55 are rejected under 35 U.S.C. 101** because the claims are directed towards nonstatutory subject matter. The cited claims are an example of functional descriptive material consisting of data structures and programs that impart functionality when employed as executed by a computer component because the claimed server may be interpreted to include only software. The functionality of functional descriptive material is realized only when the functional descriptive material is claimed as being embodied on a computer readable medium and is claimed as executed by a computer component. The cited claims provide no tangible computer

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components that work in conjunction with the functional descriptive material to impart functionality and as a result the claims are not statutory because they fail the practical application requirement of § 101 by failing to provide a useful, concrete, and tangible result (see MPEP 2106).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-5, 11-16, 22, 46, 49, 50, and 53-55 rejected under 35 U.S.C. 103(a)** as being unpatentable over MacDoran et al US Patent No. 5,757,916 in view of Brebner et al US PGPub 2002/0194266.

5. **With regards to claims 1 and 53-55**, MacDoran teaches an entity which processes transmitting data (MacDoran, column 10 lines 26-54, authentication server 150 processes authentication requests), comprising a transmitting data receiver which receives the transmitting data (MacDoran, column 10 lines 26-54, authentication server receives digital packets containing state vector observations from client), a first entity position acquisition which acquires entity position information to specify a place where the entity is installed when the transmitting data receiver has received the print

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transmitting data, this entity position information being regarded as first entity position information (MacDoran, column 10 lines 55-67, GPS signals arrive at host authentication server), a judgment section which judges whether the entity transmitting data matches the first entity position information (MacDoran, column 11 lines 31-49, if location signature matches then access to the host is granted), and an executor which executes an operation based on the entity transmitting data when the judgment section judges that the entity transmitting data matches the first entity position information and restricts the operation based on the entity transmitting data when the judgment section judges that the entity transmitting data does not match the first entity position information (MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match). MacDoran fails to teach the entity being a printer. However, Brebner teaches the determining of the location of a printer (Brebner, paragraph 0020, paragraph 0023, gps determines location of the printer). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Brebner's method of locating a printer because it offers the advantage of allowing the determination of an office address and pinpointing the location of particular resources (Brebner, paragraph 0006).

6. **With regards to claims 2, 13**, MacDoran as modified teaches the print executor does not execute the print operation based on the print transmitting data when the judgment section judges that the print transmitting data does not match the first printer position information (MacDoran, column 11 lines 31-49, allows access to the host or

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denies access to the host depending on whether there is a location match, Brebner, paragraph 0020, paragraph 0023, gps determines location of the printer).

7. **With regards to claims 3, 14**, MacDoran as modified teaches a position information acquisition request receiver which receives a position information acquisition request transmitted from a print client (Brebner, paragraph 0025, device makes request over LAN for location of printer), a second printer position acquisition which acquires printer position information to specify a place where the printer is installed when the position information acquisition request receiver has received the position information acquisition request, this printer position information being regarded as second printer position information (Brebner, paragraph 0020, paragraph 0023, location of printer is determined using GPS), and a printer position information transmitter which transmits the second printer position information to the print client which has transmitted the position information acquisition request (Brebner, paragraph 0027, returns the location data to the requesting device).

8. **With regards to claims 4, 15**, MacDoran as modified teaches the print transmitting data received by the print transmitting data receiver contains the second printer position information (MacDoran, column 11 lines 32-49, authentication server gets previously registered authentication credentials, column 10 lines 40-55, authentication processor) and the judgment section judges whether the second printer position information contained in the print transmitting data and the first printer position information acquired by the first printer position acquisition coincide (MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on

whether there is a location match), judges that the print transmitting data matches the first printer position information when the two pieces of the printer position information coincide (MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match), and judges that the print transmitting data does not match the first printer position information when the two pieces of the printer position information do not coincide (MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match).

9. **With regards to claims 5, 16**, Earl teaches the print transmitting data received by the print transmitting data receiver contains the second printer position information (MacDoran, column 11 lines 32-49, authentication server gets previously registered authentication credentials, column 10 lines 40-55, authentication processor) and the judgment section judges whether a difference between the second printer position information contained in the print transmitting data and the first printer position information acquired by the first printer position acquisition is within a predetermined range (MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match, column 13 lines 1-15, proximity criteria, column 9 lines 10-25, proximity criteria), judges that the print transmitting data matches the first printer position information when the difference between the two pieces of the printer position information is within a predetermined range (MacDoran, column 9 lines 10-25, proximity criteria, must be within particular city, city block, etc, column 11 lines 31-49, allows access to the host or denies access to the

host depending on whether there is a location match), and judges that the print transmitting data does not match the first printer position information when the difference between the two pieces of the printer position information is not within the predetermined range (MacDoran, column 9 lines 10-25, proximity criteria, must be within particular city, city block, etc, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match).

10. **With regards to claims 11, 22**, MacDoran as modified teaches that when acquiring the printer position information, the first printer position acquisition acquires the printer position information from one position detector capable of position detection out of plural position detectors (Brebner, paragraph 0023, GPS or other system).

11. **With regards to claims 12, 46, 49-50**, MacDoran teaches receiving the print transmitting data (MacDoran, column 10 lines 26-54, authentication server 150 processes authentication requests), acquiring entity position information to specify a place where the entity is installed when the entity transmitting data has been received and regarding this entity position information as first entity position information (MacDoran, column 10 lines 55-67, GPS signals arrive at host authentication server), judging whether the entity transmitting data matches the first entity position information (MacDoran, column 11 lines 31-49, if location signature matches then access to the host is granted), executing an operation based on the entity transmitting data when it is judged that the entity transmitting data matches the first entity position information and restricting the entity operation based on the entity transmitting data when it is judged that the entity transmitting data does not match the first entity position information

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(MacDoran, column 11 lines 31-49, allows access to the host or denies access to the host depending on whether there is a location match). MacDoran fails to teach the entity being a printer. However, Brebner teaches the determining of the location of a printer (Brebner, paragraph 0020, paragraph 0023, gps determines location of the printer). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Brebner's method of locating a printer because it offers the advantage of allowing the determination of an office address and pinpointing the location of particular resources (Brebner, paragraph 0006).

12. **Claims 6 and 17 are rejected under 35 U.S.C. 103(a)** as being unpatentable over MacDoran et al US Patent No. 5,757,916 and Brebner et al US PGPub 2002/0194266, as applied to claims 3 and 14 above, and in further view of Girerd et al US Patent No. 6,131,067.

13. **With regards to claims 6, 17**, MacDoran as modified teaches print clients as described above, but fails to teach an authentication information receiver which receives authentication information from the client and an authentication information judgment section which judges whether the authentication information received by the authentication information receiver coincides with previously registered authentication information wherein the position information transmitter transmits the second printer position information to the client only when the two pieces of the authentication information coincide in the authentication information judgment section. However, Girerd teaches an authentication information receiver which receives authentication

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information from the client (Girerd, column 5 lines 50-64, provides password) and an authentication information judgment section which judges whether the authentication information received by the authentication information receiver coincides with previously registered authentication information (Girerd, column 5 lines 50-64, compares to pre-established account) wherein the position information transmitter transmits the second position information to the client only when the two pieces of the authentication information coincide in the authentication information judgment section (Girerd, column 5 lines 50-64, location service provided if password allows charging account for location service). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to utilize Girerd's method of authenticating because it offers the advantage of ensuring that a user's account may be charged for the providing of a service (Girerd, column 5 lines 51-64).

Allowable Subject Matter

14. Claims 7-10 and 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art teach methods of authorizing operations based upon location and security for printers. The cited prior art fails to teach or suggest a public key acquisition request receiver which receives a public key acquisition request transmitting

from a print client, a second printer position acquisition which acquires printer position information on the printer when the public key acquisition request receiver has received the public key acquisition request, a public key generator which generates a public key with a first pass phrase containing at least the second printer position information, and a public key transmitter which transmits the public key generated by the public key generator to the print client which has transmitted the public key acquisition request. As a result, the cited prior art fails to anticipate or render obvious the above cited claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
16. Yacoub US Patent No. 6,552,813 discloses directing print jobs in a network printing system.
17. Glick et al US Patent No. 6,985,588 discloses a system and method for using location identity to control access to digital information.
18. Dennison et al US Patent No. 5,815,814 discloses a cellular telephone system that uses position of a mobile unit to make call management decisions.
19. Cannon et al US PGPub 2002/0094777 discloses enhanced wireless network security using GPS.
20. Stephens et al US PGPub 2003/0095524 discloses virtual linking using a wireless device.

21. Hansen US PGPub 2003/0101342 discloses a secure printing system and method.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Nalven whose telephone number is 571 272 3839. The examiner can normally be reached on Monday - Thursday 8-6, Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Zand can be reached on 571 272 3811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Andrew Nalven

A handwritten signature in black ink, appearing to read "Andrew Nalven", written over a horizontal line.